

REMARKS

Claims 1, 4-9, 11, 28-33 are pending in this Application. Claims 2, 3, 10 and 12-24 were previously canceled, and Claims 25-27 were withdrawn without prejudice.

New Matter

The Examiner has made the following rejection at page 2 of the Office Action:

Claims 1 and 4-9, 11, and 28-33 are rejected under 35 USC 112 first paragraph and 35 USC 132 as the specification as originally filed does not provide support for the invention as is now disclosed:

The range of amounts of between about 12 to 17 weight percent of total cellulose fibers has no *literal* support and is thus new matter in the independent claims or any other claim it is used.

Also new claims 29-33 also present this range of about 12 to 17 wt% which is new matter (regarding amount of cellulose fibers) as well as other ranges such as 12-14 wt% cellulose fibres (claim 31) and other ranges of components that would not appear to have original literal support.

Applicant is aware of no authority for a requirement of "original literal support" under 35 U.S.C. § 112, first paragraph, and appears to be an arbitrary and capricious application of the patent rules. The Examiner appears to asserting his own principle of patent law, namely, that a range must be explicitly stated in the specification using the very words of the claim, thereby adopting his own *ipsa verbis* test, and otherwise disregarding the specification and drawings as well as the authority of MPEP §2163.04 that instructs that a "description is presumed to be adequate" and places the burden *on the Examiner* to demonstrate "why a person of ordinary skill in the art would not recognize in applicant's disclosure a description of the invention defined by the claims." Figures 2 through 4 show these unexpected improvements in overall strength reflected by enhanced modulus of rupture (Fig. 2), strain (Fig. 3), and toughness (Fig. 4) exhibited by fiber cement composites have a bleached fiber concentrations in the range of 12 to 17%. It is the Examiner's burden to demonstrate "why a person of ordinary skill would not

recognize in applicant's disclosure" a fiber cement composite having 12 to 17 weight percent bleached fibers per total fibers as "a description of the invention defined by the claims," for instance, Claims 1, 28, and 30, and their rejected dependent claims. Applicant submits that the Examiner has not met the burden: He has not provided any reason why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. The Examiner further has not disputed Applicant's reference to Figures 2 through 4 provided by Applicant with its last response in support of the range the Examiner now disputes. Accordingly, Applicant respectfully requests that this rejection of Claims 1 and 4-9, 11, and 28-33 be withdrawn.

Rejection for Obviousness-Type Double Patenting (ODP)

Claims 1 and 4-11 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over all claims of U.S. Patent No. 6,506,248 B1 and 6,346,146 B1. Terminal Disclaimers drawn to U.S. Patent No. 6,506,248 B1 and 6,346,146 B1, respectively, are provided with this Amendment.

Rejection under 35 U.S.C. § 102 (a) and (e)

The claims are rejected under § 102(a) and (e) as being anticipated by each of two patents filed by Duselis *et al.*, U.S. Patent Nos. 6,506,248 ("Duselis '248") and 6,346,146 ("Duselis '146"). The basis is that "Duselis *et al.* teach a composition comprising a combination or blend of bleached and unbleached cellulose fibers in amounts overlapping applicant's claims...and thus anticipate applicant's claims." Duselis *et al.* teaches a broad range or genus. But a broad range or genus does not anticipate a specific range like that recited in Claims 1 and 29 that recite a range of 12 to 17 weight percent of bleached fibers relative to the total cellulose fiber content.

This range is not anticipated by Duselis *et al.* Overlapping ranges fails to anticipate a recited species range if a specific embodiment is not disclosed. As explained in MPEP § 2131.03, a prior art genus cannot anticipate a claimed species, where the prior art range is not supported by a specific embodiment. The Duselis references do not suggest the unexpected improvements in strength that 12 to 17 weight percent bleached fibers conveys to a fiber cement composition that are clearly reflected by Figures 2 through 4 concerning enhanced modulus of rupture (Fig. 2), strain (Fig. 3), and toughness (Fig. 4).

Rejections under 35 U.S.C. § 103

The rejection under § 103(a) is in view of each Duselis reference, or alternatively, in view of Cook *et al.* (U.S. Patent No. 6,942,726) and Gregerson *et al.* (EP 263723).

The Examiner states that the Duselis references do not teach specific fiber types (Office Action, p. 4) or lengths (Office Action, p. 5). As discussed above, neither Duselis reference suggests the unexpected results in improved modulus of rupture, strain and toughness that fiber cement composites exhibit having 12 to 17 weight percent bleached fibers per total fibers demonstrated by Figures 2, 3, and 4 (modulus of rupture, strain, and toughness, respectively). The Duselis references do not suggest the unexpected results achieved by a composite material having bleached cellulose fibers comprising between 12 and 17 weight percent of the total cellulose fiber content recited in independent Claims 1, 28 and 30, which Applicant respectfully and verily submits are patentably distinguishable over the Duselis references. Cook *et al.* is relied on for the teaching of specific examples of cellulose fibers and relies on Gregerson *et al.* for the teaching of specific fiber lengths. Gregerson fails to teach or suggest the recited proportion of bleached fibers of between about 12 to 17 weight percent, and in fact, Gregerson would find the result surprising considering that in most cases Gregerson teaches utilizing the

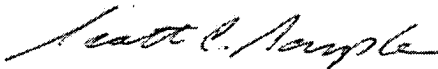
Response to the Office Action mailed August 8, 2008
Attorney Docket No. 129843-1080
U.S. Ser. No. 10/753,089

bleached to unbleached fibers in a ratio of three to one and provides no teaching or suggestion of the unexpected results obtained with the recited concentration of bleached fibers. Gregerson in combination with Duselis and Cook also fails to teach or suggest the claimed invention of Claims 1, 28 and 30. For at least these reasons, dependent Claims 4-9, 11, 29, and 31-33, are also believed to be patentable and applicant respectfully requests their reconsideration for allowance.

Applicant hereby authorizes the Commissioner to charge any additional fees or refunds that may be required or owed to Gardere Wynne Sewell LLP Deposit Account No. 07-0153.

Please direct all correspondence to the practitioner listed below at Customer No. 60148.

Respectfully submitted,
GARDERE WYNNE SEWELL LLP



Scott C. Sample
Reg. No. 52,189
Telephone: 214.999.4712
[February 6, 2009]

Attached:

Terminal Disclaimer to U.S. Patent No. 6,506,248 B1
Terminal Disclaimer to U.S. Patent No. 6,346,146 B1